

PATENT
Attorney Docket No.: GENE1120-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Nolan et al.

Application No.: 09/342,024

Filed: June 28, 1999

For: HIGH EFFICIENCY TRANSFECTION
BASED ON LOW ELECTRIC FIELD
STRENGTH, LONG PULSE LENGTH

) Group Art Unit: 3762

)

) Examiner: Unassigned

)

) CERTIFICATION UNDER 37 CFR § 1.8

)

) I hereby certify that the documents referred to as enclosed herein
) are being deposited with the United States Postal Service as first
) class mail on this date **January 26, 2000**, in an envelope
) addressed to: Assistant Commissioner for Patents, Washington,
) D.C. 20231

)

) (Name of person mailing paper)

)

) Signature

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Assistant Commissioner of Patents
Washington, D.C. 20231

PETITION TO ACCEPT FILING OF DECLARATION UNDER 37 C.F.R. § 1.47

Applicant hereby petitions for filing of declaration on behalf of himself and non-signing inventor under 37 C.F.R. § 1.47.

In response to the Notice to File Missing Parts of Application mailed July 27, 1999, and to fulfil the requirements of filing under 37 C.F.R. § 1.53, Applicant submits an executed Declaration for Patent Application signed by Inventor Ed Nolan. A Declaration for Patent Application signed by Inventor Robin Filshie is not included with the response as Inventor Filshie can not be found despite diligent effort. A Declaration of Facts fully describing the exact facts that are relied upon to establish that a diligent effort was made is attached hereto.

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Nolan et al.
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Page 2

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The last known address of the non-signing inventor is the following:

Robin Filshie
406 Rushton Road
Toronto, Ontario M6C 2X9
CANADA

The Commissioner is hereby authorized to charge \$130.00 to cover the fee for filing this petition and any associated fees, or credit overpayment to Deposit Account No. 07-1895. A copy of the Transmittal Sheet is enclosed.

Respectfully submitted,

Date: 1/26/00



Lisa A. Haile, Ph.D.
Registration No. 38,347
Telephone: (858) 677-1456
Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1600
San Diego, California 92121-2189



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) Signature

Elizabeth Lee
E. Lee

Box MISSING PARTS
Assistant Commissioner of Patents
Washington, D.C. 20231

DECLARATION OF FACTS

I, Lisa A. Haile declare that:

1. Robin Filshie was employed by BIOCATALYST YORKTON INC., located in Toronto, Ontario, Canada, and is obligated to assign the Invention to GENETRONICS, INC.;
2. A letter was sent to Dr. Dietmar Rabussay, Vice President of Research & Development of GENETRONICS, INC., on October 11, 1999 notifying Dr. Rabussay of the requirement that each inventor sign a Declaration for Patent Application (Exhibit A: letter to Dr. Rabussay);
3. A Declaration for Patent Application was sent by Federal Express International Priority Letter Service to Inventor Filshie on October 12, 1999 for his execution. (Exhibit B: Federal Express International Waybill);
4. The Declaration described in item 3 was returned as undeliverable by Federal Express on October 19, 1999 (Exhibit C: Federal Express Receipt);

5. A facsimile was sent to Nancy Martorana, assistant to Dr. Dietmar Rabussay of GENETRONICS, Inc. on January 6, 2000 informing her that a viable home address for Inventor Filshie was not yet available (Exhibit D: facsimile to Nancy Martorana);
6. A telephone call to Inventor Filshie at Biocatalyst Yorkton, Inc. was placed on January 6, 2000, but contact with Inventor Filshie was not made;
7. A letter and second Declaration for Patent Application was sent by U.S. Certified Mail to Inventor Filshie on January 6, 2000 (Exhibit E: letter to Inventor Filshie and Receipt for U.S. Certified Mail);
8. No executed Declaration for Patent Application has been received from Inventor Filshie and Inventor Filshie has not responded to any communications from, and has not been in communication with the undersigned.

I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

No fee is deemed necessary in connection with the filing of this paper. However, if any fee is required, the Commissioner is hereby authorized to charge the amount of this fee, or credit any overpayments, to Deposit Account No. 07-1895. A copy of this Transmittal Sheet is enclosed.

Respectfully submitted,

Date: 1/26/00



Lisa A. Haile, Ph.D.

Registration No. 38,347

Telephone: (858) 677-1456

Facsimile: (858) 677-1465

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LISA A. HALE, PH.D.

Writers Direct Dial: 858-677-1456

Internet: lhaile@graycary.com

October 11, 1999



Via FedEx

Dr. Dietmar Rabussay
Vice President of Research & Development
GENETRONICS, INC.
11199-A Sorrento Valley Road
San Diego, CA 92121-1334

Re: United States Patent Application 09/342,024
Entitled: HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC
FIELD STRENGTH, LONG PULSE LENGTH
Inventors: Ed Nolan, et al.
Filed: June 28, 1999
Our Docket No.: GENE1120-1

Dear Dr. Rabussay:

The above-identified patent application was filed with the United States Patent and Trademark Office on June 28, 1999, and has been assigned Serial Number 09/342,024. A copy of the filing receipt and patent application as filed is enclosed for your files. You may now mark articles made in accordance with the invention with "Patent Pending" or "Patent Applied For." We will inform you of the serial number assigned by the PTO upon receipt of such information from the PTO.

In order to complete the formalities required to obtain our June 28, 1999 filing date, please have the inventors sign the enclosed Declaration and Assignment forms as indicated. In addition, please have the enclosed Power of Attorney By Assignee signed by an officer of Genetronics, Inc. and return the executed forms to us as soon as possible.

Also enclosed is a Verified Statement Claiming Small Entity Status form which, if applicable to this case, must be signed by an officer of Genetronics, Inc.

Please note that the declaration contains an acknowledgment of the inventor's duty to disclose all information of which he is aware that is material to the examination of the application. This is a continuing duty which does not terminate upon filing of the application. The same duty is imposed on us as attorneys. The purpose of the disclosure requirement is to ensure that the

Gray Cary Ware & Freidenrich LLP

Dr. Dietmar Rabussay
Vice President of Research & Development
Genetronics, Inc.
October 11, 1999
Page 2

Patent and Trademark Office has before it all of the prior art that may affect the validity of a patent. This has the effect of strengthening patents that ultimately are granted. Failure to satisfy the disclosure requirement may result in loss of patent rights, as well as other potentially serious consequences.

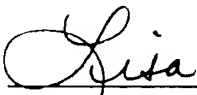
Accordingly, if you have not already provided us with all such information, we need it as soon as possible so that we can make an early determination as to its materiality, and can prepare an appropriate statement, if necessary, for filing with the application. For purposes of determining what information you should forward to us, we suggest you consider "material information" to include information relating to any publication, public uses or offers for sale of the invention or anything closely similar to it, occurring before the filing date of the application. If any such publications are patents, we suggest you consider them material no matter when issued.

As you may be aware, for a variety of reasons even "material information" may ultimately have little or no bearing on the patentability of the invention. For example, if a publication occurred less than a year before the filing date and after completion of the invention, it will not affect patentability. Moreover, an invention often can be distinguished over material information by appropriate argument to the Patent and Trademark Office, or by amendment of the claims.

In the meantime, if you have any questions or if I can provide any additional information, please do not hesitate to call.

Sincerely,

GRAY CARY WARE & FREIDENRICH LLP

By: 

Lisa A. Haile, Ph.D.

LAH/ep
Enclosures

cc: Ed Nolan
Robin Filshie

GT\6138438.1
104648-157591

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Lisa A. Haile, Ph.D.
Gray Cary Ware & Freidenrich LLP
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ROBIN FILSHIE

406 RUSHTON ROAD

TORONTO, ONTARIO M6C 2X9
ON M6C2X9 CANADA (CA)

REF: LAH/21489[104648-157591]

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SHIP DATE: 12 OCT 99
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100 Valleybrook Dr.

CITY/VILLE
Don Mills

COUNTRY/PAYS
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FAX TRANSMISSION COVER SHEET

January 6, 2000

To:

**Nancy Martorana
Genetronics, Inc.**

Telephone:

858-410-3183

Fax Number:

858-410-3397

From: Lisa A. Haile, Ph.D.
858-677-1456

Client-Matter Number: 104648-990000

Re: United States Patent Application No. 09/342,024
Entitled: HIGH EFFICIENCY TRANSFECTION BASED ON LOW ELECTRIC
FIELD STRENGTH, LONG PULSE LENGTH

Filed: June 28, 1999

Inventor(s): Nolan, et al.

Our Docket No.: GENE1120-1

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Message:

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URGENT

Please note that we are still awaiting receipt of the Declaration and Assignment forms signed by Ed Nolan for the above-identified application so that we may file with PTO. We ask that you please have these documents signed and faxed to us as soon as possible [FAX#: 858-677-1465]. Enclosed for your reference is our letter dated October 11, 1999.

Also, note that we are still not able to get a viable home address for Robin Filshie.

If you should have any questions, please do not hesitate to contact me.

Thank you.

CONFIDENTIALITY NOTICE

This communication is ONLY for the person named above. Unless otherwise indicated, it contains information that is confidential, privileged or exempt from disclosure under applicable law. If you are not the person named above, or responsible for delivering it to that person, be aware that disclosure, copying, distribution or use of this communication is strictly PROHIBITED. If you have received it in error, or are uncertain as to its proper handling, please immediately notify us by collect telephone and mail the original to us at the above address. Thank you.

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Phone 858-677-1400 Fax 858-677-1465 www.graycary.com

LISA A. HAILE, Ph.D.

Admitted to practice in California

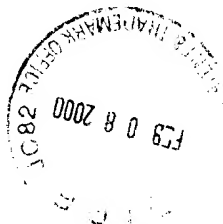
Writer's Direct Dial: 858-677-1456

Internet: lhaile@graycary.com

January 6, 2000

BY CERTIFIED MAIL

Robin Filshie
406 Rushton Road
Toronto, Ontario M6C 2X9
CANADA



Re: United States Patent Application No. 09/342,024
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If you should have any questions, please do not hesitate to contact me.

Very truly yours,

GRAY CARY WARE & FREIDENRICH LLP

By: Lisa A. Haile/ep
Lisa A. Haile, Ph.D.

LAH:ep
Enclosure

Gray Cary\GT\6162792.1
104648-990000